REMARKS/ARGUMENTS

This amendment responds to the Office Action dated March 3, 2009, in which the Examiner objected to claims 4 and 9, and rejected claims 1-6 and 8-11 under 35 U.S.C. § 103.

As indicated above, claims 4 and 9 have been amended. Therefore, Applicants respectfully request the Examiner withdraws the objection to claims 4 and 9.

As indicated above, claims 1, 4 and 8-9 have been amended in order to make explicit what is implicit in the claims. The amendment is unrelated to a statutory requirement for patentability. Claims 10 and 11 have been amended for stylistic reasons. The amendments are unrelated to a statutory requirement for patentability and do not narrow the literal scope of the claims.

Claims 1 and 8 claim a recording system for recording and/or reserving a program. The recording system comprises a request accepting portion/means, a local storage/means, connection portion/means, determining portion/means and issuing portion/means. The accepting portion/means accepts a request to record and/or reserve a program. The local storage portion/means records the program. The connection portion/means connects, via a wide area network with an external device which is external to the recording system. The determination portion/means determines a malfunction in the local storage means. The malfunction disables recording the program requested on the local storage portion/means. The issue portion/means issues a recording substitution request, based on the determination result, to the external device via the wide area network to record the program in response to the determination portion/means determining the malfunction in the local storage means/portion.

By having a determination means/portion determine a malfunction in the local storage means/portion and by having an issue mean/portion issue a recording substitution request based

on the determination mean/portion determining the malfunction as claimed in claims 1 and 8, the claimed invention provides a recording system which allows a program to be recorded even when a failure in the local storage device prevents the program from being recorded. The prior art does not show, teach or suggest the invention as claimed in claims 1 and 8.

Claims 4 and 9 claim a recording substitution system for substitutionally recording a program. The recording substitution system includes a connection portion/means for connecting via a wide area network with external devices. A receiving portion/means reeeives a program. A storage portion/means records the program. A recording substitution portion responds to reception of a recording substitution request from one of the external devices via the connection portion and receives and records a program corresponding to the request in the storage portion/means. The recording substitution portion stores new advertising content received from another external device, as a replacement or as an insertion for advertising in the recorded program.

By having a recording substitution mean/portion which either (a) stores advertising information for insertion into a recorded program or (b) stores the advertising information as a substitute for the original commercial information in the recorded program as claimed in claims 4 and 9, the claimed invention provides a recording substitution system which will record a program with personalized advertisement. The prior art does not show, teach or suggest the invention as claimed in claims 4 and 9.

Claims 1-3 were rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* (U.S. Patent No. 6,311,011) in view of *Ellis, et al.* (U.S. Publieation No. 2003/0149988).

Kuroda appears to disclose in FIG. 7 at step S107, a dialogue box of FIG. 6 warns that the storage device selected does not have sufficient capacity for recording the contents and

allows a viewer a choice to select another storage device or to record the storage device (Col. 5, lines 60-65). Thus, nothing in *Kuroda* shows teaches or suggests (a) determining a malfunction in the local storage means and (b) issuing a recording substitution request to an external device via a wide area network in response to the determination of the malfunction in the local storage device as claimed in claim 1. Rather, *Kuroda* only discloses a user selecting a device based upon a warning in a dialogue box.

Ellis, et al. appears to disclose a remote media server 24 records programs and associated program guide data in storage 15 in response to record requests generated by a program guide implemented on an interactive program guide television equipment 17 [0084].

Thus, *Ellis, et al.* merely discloses a server 24 recording programs in response to a user's request to record a program. Nothing in *Ellis, et al.* shows, teaches or suggests (a) determining a malfunction in a local storage means, and (b) issuing a recording substitution request to an external device via a wide area network to record a program in response to a determining means determining a malfunction in a local storage means as claimed in claim 1. Rather, *Ellis, et al.* only discloses a server 24 recording a program in response to a request generated based upon a user's wish to record a program.

A combination of *Kuroda* and *Ellis, et al.* would merely suggest that when capacity is insufficient, generating a warning to a user to select another storage device as taught by *Kuroda*, and in addition to have the user indicate which program the remote server is to record as taught by *Ellis, et al.* Thus, nothing in the combination of *Kuroda* and *Ellis, et al.* shows, teaches or suggests (a) a determining means determining a malfunction in a local storage means, and (b) issuing a recording substitution request to an external device via a wide area network in response to the determining means determining the malfunction in the local storage means as claimed in

claim 1. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claim 1 under 35 U.S.C. § 103.

Claim 2 depends from claim 1 and recites additional features. Applicants respectfully submit that claim 2 would not have been obvious within the meaning of 35 U.S.C. § 103 over *Kuroda* and *Ellis, et al.*, at least for the reasons as set forth above. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claim 2 under 35 U.S.C. § 103.

Claims 4-6 and 9 were rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* in view of *Ellis, et al.* and *Zigmond, et al.* (U.S. Patent No. 6,698,020).

As discussed above, *Kuroda* merely discloses that when insufficient capacity occurs, displaying a display to a user to allow a user to select another storage device. Nothing in *Kuroda* shows, teaches or suggests a recording substitution means stores advertising information in a storage means as an insert in a recorded program stored in the recording means in addition to the original commercial information, or stores the advertising information in the storage means as a substitute for the original commercial information included in the recorded program stored in the storage means as claimed in claims 4 and 9. Rather, *Kuroda* only discloses that when a remaining capacity occurs, displaying a screen to a viewer to allow the viewer to select another storage device.

As discussed above, *Ellis, et al.* merely discloses that upon a user selection, having a program guide generate a record request to a remote media server. Nothing in *Ellis, et al.* shows, teaches or suggests a recording substitution means either stores advertising information in a storage means as an insert in a recorded program stored in the storage means in addition to the original recorded information, or stores the advertising information in the storage means as a substitute for the original commercial information included in the recorded program stored in the

storage means as claimed in claims 4 and 9. Rather, *Ellis, et al.* only discloses that upon a user requesting to record a program, a program guide television equipment generates a record request to a remote media server 24.

Zigmond, et al. appears to disclose that during display of a video programming feed, a selected advertisement is displayed at an appropriate time based on a triggering event (column 4, lines 36-52). An insertion device 80 includes a mean for detecting a triggering event indicating an appropriate time to display the selected advertisement (column 15, lines 35-37). The system may be used to select appropriate advertisement based on whether the video programming feed is watched as a broadcast or replayed from recorded media. Advertisers can thus update time-sensitive advertisements when advertisements have been recorded. Furthermore, originally recorded advertisements can be replaced with effectively targeted ads (column 14, lines 1-12).

Thus, *Zigmond, et al.* merely discloses that based upon a triggering event in a program feed or a recording media during replay, an appropriate advertisement is inserted into the displayed program. Nothing in *Zigmond, et al.* shows, teaches or suggests either storing advertising information in a storage means as an insert in a recorded program stored in the storage means in addition to the original commercial information included in the recorded program or storing the advertising information in a storage means as a substitute for the original commercial information included in the recorded program stored in the storage means as claimed in claims 4 and 9. Rather, *Zigmond, et al.* only discloses that during the program feed/replay, when a triggering event occurs, appropriate advertisement information is displayed.

A combination of *Kuroda*, *Ellis, et al.* and *Zigmond, et al.* would merely suggest that a user is prompted to select a storage device when a selected storage device contains insufficient capacity as taught by *Kuroda*, based upon a user's request, issuing a request to record to a remote

server as taught by *Ellis, et al.* and during program feed or replay when a triggering event occurs, advertisement is selected and displayed as taught by *Zigmond, et al.* Thus, nothing in the combination of the references shows, teaches or suggests storing advertising information in a storage means as an insert in a recorded program stored in a storage means in addition to the original commercial information, or storing advertising information in the storage means as a substitute for the original commercial information included in the recorded program as claimed in claims 4 and 9. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claims 4 and 9 under 35 U.S.C. § 103.

Claims 5-6 depend from claim 4 and recite additional features. Applicants respectfully submit that claims 5-6 would not have been obvious within the meaning of 35 U.S.C. § 103 over *Kuroda*, *Ellis, et al.* and *Zigmond, et al.* at least for the reasons as set forth above. Therefore, Applicants respectfully request the Examiner withdraws the rejections to claims 5-6 under 35 U.S.C. § 103.

Claim 8 was rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* in view of *Lawler, et al.* (U.S. Patent No. 5,805,763).

Kuroda discloses a temporary storage device 103 which temporarily stores content signals. A controller 104 controls the time for the temporary storage device 103 to store content signals by comparing present time with program information recorded. When the amount of programs recorded in the temporary storage device 103 overflows in comparison with time or number of programs predetermined by a viewer, the controller 104 deletes the oldest content from the storage device 103 (column 4, lines 25-37). A storage device 105 stores content signals according to a viewer's direction (column 4, lines 38-39). With time-shift recording, a program is temporarily recorded and played back later (column 11, lines 66-67). If a viewer directs to

record a program before the program is deleted from the temporary storage device 103, the program is moved to the storage device 105 not to be deleted automatically (column 12, lines 16-23).

Thus, *Kuroda* merely discloses that when a time-shift record is selected by a viewer, the program that is stored in the temporary storage device 103 is moved to the storage device 105 where it is not automatically deleted. Nothing in *Kuroda* shows, teaches or suggests determining a malfunction in a local storage portion and automatically issuing a record substitution request to an external storage device via a wide area network in response to determining a malfunction in a local storage portion as claimed in claim 8. Rather, *Kuroda* only discloses that for a time-shift record, the information is initially stored in the temporary storage device 103, but is subsequently moved to the storage device 105 so that it is not automatically deleted.

Lawler, et al. appears to disclose a user can set a record tag by activating the Record button 130 in the menu 136 (column 12, lines 29-32). A record tag can be thought up as a request to the system to record a program. Each record tag is associated with the program to be recorded in the viewer's station or user that set the record tag (column 12, lines 58-61). When a record tag is set, it is stored at the head end 12. In this manner, the head end can monitor all the record tags set by the various system users (column 13, lines 8-12). In an alternative embodiment, a recording device is associated with the head end 12. The head end monitors the recording tags of all system users and if any user has set a record tag, the head end controls the recording device to record the program (column 13, lines 26-37).

Thus, *Lawler, et al.* merely discloses having a user set a record tag and the system monitoring thereof. Nothing in *Lawler, et al.* shows, teaches or suggests (a) determining a malfunction in a local storage portion and (b) automatically issuing a record substitution request

to an external storage device via a wide area network in response to the determination of the malfunction of the local storage portion as claimed in claim 8. Rather, *Lawler, et al.* merely discloses a user setting a record tag and monitoring of the tag by the system.

A combination of *Kuroda* and *Lawler, et al.* would merely suggest that during a time-shift operation, to temporarily store the viewer directed program onto the temporary storage device and then to move it to the storage device 105 so that it is not deleted is taught by *Kuroda*, and in addition to have the user set a record tag and to have the system monitor the tag as taught by *Lawler, et al.* Thus, nothing in the combination of the references shows, teaches or suggests (a) determining a malfunction in a local storage portion, and (b) automatically issuing a record substitution request to an external storage device via a wide area network in response to the determination of the malfunction in the local storage portion as claimed in claim 8. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claim 8 under 35 U.S.C. § 103.

Claim 10 was rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* in view of *Ellis, et al.* and further in view of *Zigmond, et al.* Claim 11 was rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* in view of *Lawler, et al.* and further in view of *Zigmond, et al.*

Applicants respectfully traverse the Examiner's rejection of claims 10 and 11 under 35 U.S.C. § 103. The claims have been reviewed in light of the Office Action and for reasons which will be set forth below, Applicants respectfully request the Examiner withdraws the rejection to the claims and allows the claims to issue.

As discussed above, since nothing in the reference to *Kuroda* shows, teaches or suggests the primary features as claimed in claims 1 and 8, Applicants respectfully submit that the

combination in the primary reference with the secondary references to *Ellis, et al.*, *Zigmond, et al.* and *Lawler, et al.* will not overcome the deficiencies of the primary reference. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claim 10 and 11 under 35 U.S.C. § 103.

Thus, it now appears that the application is in condition for a reconsideration and allowance. Reconsideration and allowance at an early date are respectfully requested.

CONCLUSION

If for any reason the Examiner feels that the application is not now in condition for allowance, the Examiner is requested to contact, by telephone, the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed within the currently set shortened statutory period, Applicants respectfully petition for an appropriate extension of time. The fees for such extension of time may be charged to Deposit Account No. 50-0320.

In the event that any additional fees are due with this paper, please charge our Deposit Account No. 50-0320.

Respectfully submitted,

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Date: June 2, 2009

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